



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,178	04/09/2001	Tabitha Ferguson	555255012228	9229
7590	10/06/2003		EXAMINER	
David B. Cochran, Esq. Jones, Day, Reavis & Pogue North Point 901 Lakeside Avenue Cleveland, OH 44114			PHAM, KHANH B	
			ART UNIT	PAPER NUMBER
			2177	13
DATE MAILED: 10/06/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/829,178	FERGUSON ET AL.
	Examiner	Art Unit
	Khanh B. Pham	2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 April 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-50 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-50 is/are rejected.

7) Claim(s) 46 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-12.

4) Interview Summary (PTO-413) Paper No(s). _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. **A new title is required** that is clearly indicative of the invention to which the claims are directed.

Claim Objections

2. Claim 46 is objected to because of the following informalities: step (F) should be changed to (E) because step (E) does not exist. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 14-15, 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Lincke (US 6,360,272 B1).**

As per claim 14, Lincke teaches a method of synchronizing messages stored in a folder hierarchy at a host system and a corresponding folder hierarchy at a mobile data communication device, comprising the steps of:

- “receiving a message at the host system; storing the message in a first folder of the folder hierarchy at the host system” at Col. 7 lines 30-35;
- “transmitting the message to the mobile data communication device; storing the message in a first folder of the folder hierarchy at the mobile data communication device” at Col. 7 lines 50-55;
- “moving the message from the first folder to a second folder at the mobile data communication device” at Col. 1 lines 64-67 and Col. 10 lines 35-40;
- “coupling the mobile data communication device to the host system; detecting that the message has been moved to the second folder at the mobile data communication device” at Col. 10 lines 35-40;
- “and in response to the detection step, moving the message from the first folder at the host system to a second folder of the folder hierarchy at the host system that corresponds to the second folder of the folder hierarchy at the mobile data communication device” at Col. 10 lines 40-45.

As per claim 15, Lincke teaches a method of synchronizing messages stored in a folder hierarchy at a host system and a corresponding folder hierarchy at a mobile data communication device, comprising the steps of:

- “receiving a message at the host system; storing the message in a first folder of the folder hierarchy at the host system” at Col. 1 lines 50-55;
- “transmitting the message to the mobile data communication device; storing the message in a first folder of the folder hierarchy at the mobile data communication device” at Col. 1 lines 50-55;

- “moving the message from the first folder to a second folder at the mobile data communication device” at Col. 1 lines 64-67 and Col. 10 lines 35-40;
- “transmitting a move message from the mobile data communication device to the host system indicating that the message has been moved to the second folder at the mobile data communication device” at Col. 6 lines 30-40;
- “and receiving the move message at the host system and moving the message stored in the first folder at the host system to a second folder at the host system that corresponds to the second folder at the mobile data communication device” at Col. 6 lines 47-55.

As per claim 17, Lincke teaches a method of synchronizing a first device to a second device, comprising the steps of:

- “providing a first folder hierarchy at the first device” at Col. 1 line 64-67;
- “providing a second folder hierarchy at the second device” at Col. 1 lines 64-67;
- “retrieving a first plurality of messages stored within the first folder hierarchy and retrieving a second plurality of messages stored within the second folder hierarchy” at Col. 5 lines 24-65;
- “determining whether the first device executed an operation on a message stored in the first folder hierarchy, and if so, then executing the same operation on a corresponding message stored in the second folder hierarchy at the second device” at Col. 2 lines 55-61 and Col. 6 lines 47-55.

As per claim 18, Lincke teaches the method of claim 17, further comprising the step of “synchronizing the second folder hierarchy to the first folder hierarchy” at Col. 4 lines 8-19.

As per claim 19, Lincke teaches a system for synchronizing messages between a first device and a second device, comprising:

- “a pair of matching folders, one of the pair of matching folders being located on the first device, the other of the pair of matching folders being located on the second device” at Col. 1 lines 64-67;
- “a pair of matching messages, one of the pair of matching messages being located on the first device, the other of the pair of matching messages being located on the second device” at Col. 2 lines 25-30;
- “and means for moving the pair of messages such that if one of the pair of matching messages is moved to one of the pair of matching folders, the other matching message is moved to the other matching folder” at Col. 6 lines 20-55.

As per claim 20, Lincke teaches the system of claim 19, wherein “the first device is a host system and the second device is a mobile data communications device” at Fig. 1, elements 110, 108.

As per claim 21, Lincke teaches the system of claim 19, wherein “each pair of matching messages has a unique message ID such that the means for moving comprises means for matching the unique message IDs of the message on the first device to the message on the second device by matching the unique message IDs” at Col. 5 lines 30-40 and Col. 6 lines 20-55.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 1-13, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman (US. 6,505,214 B1), and in view of Lincke (US 6,360,272 B1).**

As per claim 1, Sherman teaches a method of synchronizing messages between a first system and a second system, comprising the steps of:

- “retrieving a first folder hierarchy from the first system, retrieving a second folder hierarchy from the second system” at Col. 13 lines 40-65;

- “synchronizing the second folder hierarchy to the first folder hierarchy” at Col. 13 lines 60-65;
- “retrieving a first plurality of messages from the first system, the first plurality of messages being stored in folders within the first folder hierarchy” at Col. 13 lines 50-65;
- “retrieving a second plurality of messages from the second system, the second plurality of messages being stored in folders within the second folder hierarchy” at Col. 13 lines 50-65;
- “comparing the first plurality of messages to the second plurality of messages to identify common messages stored in both the first and second folder hierarchies” at Col. 13 lines 55-60;

Sherman does not explicitly teach the step of: “determining whether any of the common messages are stored in different folders in the first and second folder hierarchies; and if a common message is located in different folders of the first and second folder hierarchies, then synchronizing the messages by moving the common message to a new folder within the first folder hierarchy or by moving the common message to a new folder within the second folder hierarchy”. However, Lincke teaches a similar method for synchronize messages between two systems including the step of: “determining whether any of the common messages are stored in different folders in the first and second folder hierarchies; and if a common message is located in different folders of the first and second folder hierarchies, then synchronizing the messages by moving the common message to a new folder within the first folder hierarchy or by

moving the common message to a new folder within the second folder hierarchy" at Col. 6 lines 20-55. Thus, it would have been obvious to one of ordinary skilled in the art to combine Sherman and Lincke's teaching so that after the synchronization, the storage location of the messages on the first system will be the same as the location of the messages on the second system, make it easier for user to locate the messages.

As per claim 2, Sherman and Lincke teach the method of claim 1 as discussed above. Lincke also teaches: "initiating communication between the first and second systems by electrically coupling the first system to the second system" at Col. 4 lines 55-67.

As per claim 3, Sherman and Lincke teach the method of claim 1 as discussed above. Lincke also teaches the step of "initiating communicating between the first and second systems by opening a connecting via a wireless data communication network" at Col. 4 lines 63-67.

As per claim 4, Sherman and Lincke teach the method of claim 1 as discussed above. Lincke also teaches: "the first system is a host system and the second system is a mobile data communication device" at Col. 4 lines 55-62.

As per claim 5, Sherman and Lincke teach the method of claim 4 as discussed above. Lincke also teaches the step of: "providing a wireless data communication network for enabling communications between the host system and the mobile data communication device" at Col. 4 lines 63-67.

As per claim 6, Sherman and Lincke teach the method of claim 1 as discussed above. Sherman also teaches:

- “the synchronizing the second folder hierarchy to the first folder hierarchy step further includes the steps of: associating a unique folder ID with each folder in the first and second folder hierarchies” at Col. 14 lines 33-43;
- “generating a folder list including the folder IDs of the folders in the first folder hierarchy; providing the folder list to the second system” at Col. 13 lines 50-65;
- “updating the second folder hierarchy to match the first folder hierarchy using the information contained in the folder list” at Col. 14 lines 35-55.

As per claim 7, Sherman and Lincke teach the method of claim 1 as discussed above. Sherman also teaches:

- “the comparing step further includes the steps of: associating a unique message ID with each message stored in the first and second systems” at Col. 6 line 65 to Col. 7 line 5;
- “comparing the message IDs of the messages retrieved from the first system with the message IDs of the messages retrieved from the second system in order to determine if any common messages are stored on the first and second systems” at Col. 13 lines 55-65.

As per claim 8, Sherman and Lincke teach the method of claim 1 as discussed above. Lincke also teaches the steps of: “receiving a new message at the first system, associating a unique message ID with the new message; and transmitting the new message to the second system” at Col. 5 lines 30-55.

As per claim 9, Sherman and Lincke teach the method of claim 8 as discussed above. Lincke also teaches the steps of: “receiving the new message at the second

system; and storing the new message in a first folder within the second folder hierarchy at the second system" at Col. 2 lines 25-30.

As per claim 10, Sherman and Lincke teach the method of claim 8 as discussed above. Lincke also teaches the steps of: "storing the new message into a first folder within the first folder hierarchy at the first system, wherein the first folder within the first folder hierarchy is associated with the first folder within the second folder hierarchy" at Col. 2 lines 25-30.

As per claim 11, Sherman and Lincke teach the method of claim 10 as discussed above. Lincke also teaches: "the first folders are inbox folders" at Col. 3 lines 35-45.

As per claim 12, Sherman and Lincke teach the method of claim 11 as discussed above. Lincke also teaches the steps of:

- "moving the new message to a second folder within the second folder hierarchy" at Col. 6 lines 25-30;
- "associating a folder ID of the second folder with the new message" at Col. 6 lines 25-30;
- "and setting a move flag within the new message to indicate that the new message has been moved to the second folder" at Col. 6 lines 25-30.

As per claim 13, Sherman and Lincke teach the method of claim 1 as discussed above. Sherman also teaches:

- “the determining step further includes the steps of: associating a folder ID with each message stored in the first and second folder hierarchies” at Col. 14 lines 33-43;
- “wherein the folder ID identifies the folder location of each message within the respective folder hierarchy, and wherein associated folders in the first and second hierarchies are identified by the same folder ID” at Col. 13 lines 50-65;
- “and comparing the folder IDs of any common messages to determine whether the common messages are stored in the same folders within the first and second folder hierarchies” at Col. 13 lines 50-65.

As per claim 16, Sherman teaches a method of synchronizing a first device to a second device, comprising the steps of:

- “providing a first folder hierarchy at the first device, providing a second folder hierarchy at the second device” at Col. 13 lines 40-65;
- “synchronizing the second folder hierarchy to the first folder hierarchy” at Col. 13 lines 60-65;
- “retrieving a first plurality of messages stored within the first folder hierarchy and retrieving a second plurality of messages stored within the second folder hierarchy, wherein at least one of the first plurality of messages and at least one of the second plurality of messages are common messages” at Col. 13 lines 50-65;

Sherman does not explicitly teach the step of: “determining whether the common messages are stored in similar folders within the first and second folder hierarchies; and

if the common messages are not stored in similar folders, then synchronizing the common messages so that they are stored in similar folders within the first and second folder hierarchies". However, Lincke teaches a similar method for synchronize messages between two systems including the step of: "determining whether the common messages are stored in similar folders within the first and second folder hierarchies; and if the common messages are not stored in similar folders, then synchronizing the common messages so that they are stored in similar folders within the first and second folder hierarchies" at Col. 6 lines 20-55. Thus, it would have been obvious to one of ordinary skilled in the art to combine Sherman and Lincke's teaching so that after the synchronization, the storage location of the messages on the first system will be the same as the location of the messages on the second system, make it easier for user to locate the messages.

8. **Claims 22-50 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Lincke et al. (US 6,360,272 B1) and in view of Temple ("The complete Idiot's Guide to Microsoft Outlook 2000).

As per claim 22, Lincke teaches a method of indicating at a host system a state of a message at a mobile communications device, the method comprising of the following steps:

- (A) "altering the state of a first message at the mobile communications device thereby creating an altered state" at Col. 6 lines 20-30;
- (B) "forwarding a status signal to the host system" at Col. 6 lines 20-30;

- (C) "changing at the host system a first message status (icon) based on the altered state at the mobile communications device" at Col. 6 lines 47-55.

Lincke teaches changing "a first message status" but does not explicitly teach changing "a first message status icon". However, using graphical icon to indicate status of email messages is well known in the art, as exemplary by Temple at page 79. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the "message status icon" to Lincke's invention so that the status of the messages can be easily recognized by the user and require less displayed space.

As per claim 23, Lincke and Temple teach the method of claim 22 as discussed above. Lincke also teaches: "step (A) is the act of forwarding the first message from the mobile communication device" at Col. 4 lines 1-7.

As per claim 24, Lincke and Temple teach the method of claim 22 as discussed above. Lincke also teaches: "step (A) is the act of replying to the first message from the mobile communication device" at Col. 4 lines 1-7.

As per claim 25, Lincke and Temple teach the method of claim 22 as discussed above. Lincke also teaches: "step (A) is the act of reading the first message at the mobile communications device" at Col. 4 lines 1-7.

As per claim 26, Lincke and Temple teach the method of claim 23 as discussed above. Temple also teaches: "step (C) results in the first message status icon representing a graphical representation of at least the forwarded state" at page 79, 1st paragraph.

As per claim 27, Lincke and Temple teach the method of claim 23 as discussed above. Temple also teaches: "step (C) results in the first message status icon representing a graphical representation of at least the replied state" at page 79, 1st paragraph.

As per claim 28, Lincke and Temple teach the method of claim 23 as discussed above. Temple also teaches: "step (C) results in the first message status icon representing a graphical representation of at least the read state" at page 79, 1st paragraph.

As per claim 29, Lincke and Temple teach the method of claim 22 as discussed above. Lincke also teaches: "the mobile communications device is a PDA" at Col. 4 lines 55-62.

As per claim 30, Lincke and Temple teach the method of claim 22 as discussed above. Lincke also teaches: "the mobile communications device is a pager" at Col. 4 lines 55-62.

As per claim 31, Lincke and Temple teach the method of claim 22 as discussed above. Lincke also teaches: "the mobile communications device is a two-way pager" at Col. 4 lines 55-62.

As per claim 32, Lincke and Temple teach the method of claim 22 as discussed above. Lincke also teaches: "the mobile communications device is a cellular telephone" at Col. 4 lines 55-62.

As per claim 33, Lincke and Temple teach the method of claim 22 as discussed above. Lincke also teaches: "the mobile communications device is an Internet appliance" at Col. 4 lines 55-62.

As per claim 34, Lincke teaches a method of indicating at the host system the state of the message at the mobile communications device comprising of the following steps:

- (A) "redirecting a first message from the host system to the mobile communications device" at Col. 5 lines 53-67;
- (B) "receiving the redirected first message from the host system at the mobile communications device" at Col. 5 lines 53-67;
- (C) "altering the state of the first message at the mobile communications device thereby creating an altered state" at Col. 6 lines 25-30;
- (D) "forwarding a status signal to the host system" at Col. 6 lines 20-25;
- (E) "changing at the host system the first message status based on the action taken at the mobile communications device" at Col. 6 lines 47-55.

Lincke teaches "a first message status" but does not explicitly teach "a first message status icon". However, using graphical icon to indicate status of email messages is well known in the art, as exemplary by Temple at page 79, 1st paragraph. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the "message status icon" to Lincke's invention so that the status of the messages can be easily recognized by the user and require less displayed space.

As per claim 35, Lincke and Temple teach the method of claim 34 as discussed above. Lincke also teaches: "step (A) is the act of forwarding the first message from the mobile communication device" at Col. 4 lines 1-7.

As per claim 36, Lincke and Temple teach the method of claim 34 as discussed above. Lincke also teaches: "step (A) is the act of replying to the first message from the mobile communication device" at Col. 4 lines 1-7.

As per claim 37, Lincke and Temple teach the method of claim 34 as discussed above. Lincke also teaches: "step (A) is the act of reading the first message at the mobile communications device" at Col. 4 lines 1-7.

As per claim 38, Lincke and Temple teach the method of claim 35 as discussed above. Temple also teaches: "step (C) results in the first message status icon representing a graphical representation of at least the forwarded state" at page 79, 1st paragraph.

As per claim 39, Lincke and Temple teach the method of claim 36 as discussed above. Temple also teaches; "step (C) results in the first message status icon representing a graphical representation of at least the replied state" at page 79, 1st paragraph.

As per claim 40, Lincke and Temple teach the method of claim 37 as discussed above. Temple also teaches: "step (C) results in the first message status icon representing a graphical representation of at least the read state" at page 79, 1st paragraph.

As per claim 41, Lincke and Temple teach the method of claim 34 as discussed above. Lincke also teaches: "the mobile communications device is a PDA" at Col. 4 lines 55-62.

As per claim 42, Lincke and Temple teach the method of claim 34 as discussed above. Lincke also teaches: "the mobile communication device is a pager" at Col. 4 lines 55-62.

As per claim 43, Lincke and Temple teach the method of claim 34 as discussed above. Lincke also teaches: "the mobile communication device is a two-way pager" at Col. 4 lines 55-62.

As per claim 44, Lincke and Temple teach the method of claim 34 as discussed above. Lincke also teaches: "the mobile communication device is a cellular telephone" at Col. 4 lines 55-62.

As per claim 45, Lincke and Temple teach the method of claim 34 as discussed above. Lincke also teaches: "the mobile communication device is an Internet appliance" at Col. 4 lines 55-62.

As per claim 46, Lincke and Temple teach the method of claim 33 as discussed above. Lincke also teaches: "forwarding a read-receipt to a read-receipt requester's device".

As per claim 47, Lincke and Temple teach the method of claim 46 as discussed above. Lincke also teaches: "the requester's device is a mobile communication device" at Col. 4 lines 55-62.

As per claim 48, Lincke and Temple teach the method of claim 46 as discussed above. Lincke also teaches: "the requester's device is a personal computer" at Col. 4 lines 55-62.

As per claim 49, Lincke and Temple teach the method of claim 46 as discussed above. Lincke also teaches: "the requester's device is a two-way pager" at Col. 4 lines 55-62.

As per claim 50, Lincke and Temple teach the method of claim 46 as discussed above. Lincke also teaches: "the requester's device is a Internet appliance" at Col. 4 lines 55-62.

Conclusion

9. The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is (703) 305-9601 for faster service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (703) 308-7299. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)746-7240.

Khanh B. Pham
Examiner
Art Unit 2177

KBP
September 23, 2003


JEAN R. HOMERE
PRIMARY EXAMINER